REMARKS

The office action of January 23, 2004 has been carefully reviewed and these remarks are responsive thereto. Claims 2-29 remain in this application. Claims 2, 11, 24 and 27 have been amended. Reconsideration and allowance of the instant application are respectfully requested based upon the above amendments and the following arguments.

CLAIM REJECTIONS

Rejections Based on *Nordeman* in view of *Linden* and *Caldwell*

Claims 2-4, 6-10, 12, 15, 18-22, and 24-29 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over *Nordeman*, U.S. Pat. No. 6,363,249 (hereinafter referred to as *Nordeman*) in view of *Linden et al.*, U.S. Pat. No. 6,549,773 (hereinafter *Linden*) and *Caldwell et al.*, U.S. Pat. No. 6,421,673 (hereinafter *Caldwell*).

With respect to claim 2, the office action alleges that *Nordeman* teaches backing-up data in a wireless network at column 7, lines 9-13. The action further contends that *Nordeman* teaches (at column 7, lines 18-20 and 25-27) selecting data within a wireless device for backup in a storage area, the storage area being accessible by the wireless client device through the wireless network. The office action concedes that *Nordeman* does not teach encrypting data or sending encrypted data using a Wireless Application Protocol (WAP) and instead relies on *Linden*, alleging that it shows sending information using a WAP technique at column 5, lines 15-20. The office action further concedes that *Nordeman* does not teach encrypting selected data, but rather relies on *Caldwell* to attempt to overcome the deficiency in *Nordeman*. According to the office action, it would have been obvious to one of skill in the art to combine the teachings of *Nordeman*, *Linden* and *Caldwell* to achieve the method provided in claim 2.

Applicants respectfully traverse. Claim 2 recites in relevant part:

A method for backing-up data in a wireless network, the method
comprising steps of:
selecting data within a wireless device for backup in a storage area,
the storage area being accessible by the wireless client device through the
wireless network;
encrypting the selected data; and
sending the encrypted data to the storage area

> wherein the step of sending the encrypted data to the storage area
> is done using a Wireless Application Protocol (WAP) technique.

Nordeman does not teach "selecting data within a wireless device for backup in a storage area" as recited in claim 2. *Nordeman* shows a system in which the entire contents of the subscriber unit's memory contents are maintained on the server. There is no selection of data, as all data from the memory of the subscriber unit is always copied to the server. For example, *Nordeman* states:

> By maintaining in the server 15 a current copy of the subscriber unit's
> memory contents, a subscriber unit 17 benefits from the more powerful
> processing capability and data storage capability of the server 15 for many
> applications as well as for a backup function in the event that the
> subscriber unit 17 loses the contents of its memory or possibly the unit 17
> itself is lost or destroyed and needs to be replaced.

Col. 7, lines 11-17. At most, *Nordeman* teaches a system in which a server can dynamically configure data capability profile of a subscriber unit based on the type of subscriber unit that is communicating with the server. Yet, this ability to configure a data capability profile is not selecting data. In describing a data capability profile, *Nordeman* states:

> [E]ach transmission is adapted to the respective subscriber unit's data
> capability profile, such as supported data types, number of data elements,
> size of each data element, and data type for each data element.

Col. 2, lines 4-7. Put more simply, *Nordeman* is directed to a system in which a server selects the different types of data (based on the data capabilities of a subscriber unit – i.e. based on the hardware/software capability of the subscriber unit) that may be sent from subscriber unit to server, but does it clearly does not teach selecting desired data (such as personal and/or system data) that is transmitted from subscriber unit to server. Further evidence of the difference between the selection of a data capability profile in *Nordeman* and the selection of data as recited in claim 2 of the present invention is provided at column 3, lines 30-40:

> The data packets transmitted according to this predefined datagram 200
> are customized for the specific data capability profile of each of the at
> least one subscriber unit 17 to 22 communicating messages with the server
> 15 according to the datagram 200. Because the message information is
> organized and delivered according to the specific data capabilities of a
> subscriber unit, for example as shown by 17, excess data that would

normally be ignored by the subscriber unit 17 because of internal
constraints of the subscriber unit 17 such as a maximum entry length is not
transmitted.

Plainly, *Nordeman* is directed to automatically selecting data capability profiles to remove
extraneous data from a predetermined backup routine, thereby improving the speed of the
network by reducing bandwidth requirements. Finally, neither the passages (col. 7, lines 18-20
& 25-27) cited in the office action nor any other portions of *Nordeman* show selecting data
within the wireless device for backup in a storage area.

None of the other cited references cure this deficiency in *Nordeman*. *Linden* is directed
to a method for utilizing local resources in a communication system and does not teach or
suggest selecting data in a wireless device for backup in a storage area. *Caldwell* is directed to a
method for mapping applications in a distributed network environment and does not even
remotely teach or suggest selecting data within a wireless device for backup in a storage area.

Furthermore, the office action fails to provide any suggestion or motivation to combine
the three references. The office action improperly cites a result of the combination as a
motivation to combine the references in the first place by stating that it would be obvious to
combine the references "to make the device adapt [sic] to include encrypting selected data or
sending the encrypted data using a Wireless Application Protocol (WAP) because this would
allow for data transmission between servers and wireless communications devices, which are
connected to a communications network." Even if that is true, it is impermissible hindsight and,
even if it were not impermissible hindsight, it is not what is claimed. In fact, the stated
motivation could be applied to almost any two references in the telecommunications field.

The Federal Circuit has repeatedly stated that the limitations of a claim in a pending
application cannot be used as a blueprint to piece together prior art in hindsight, *In re
Dembiczak*, 50 U.S.P.Q.2d 1614 (Fed. Cir. 1999), and that the Patent Office should **rigorously
apply the requirement** that a teaching or motivation to combine prior art references needs to be
provided. *Id.* (emphasis added). There is no motivation to combine these references, and even if
the three references were combined, the combination would lack "selecting data within a
wireless device for backup in a storage area" as recited in claim 2.

Accordingly, claim 2 is allowable. Claims 3-4 and 6-10 depend from claim 2. As a result, Applicants submit that these claims are allowable as being dependent on an allowable base claim.

Claim 3 is also allowable for other reasons as well. Claim 3 recites in relevant part:

The method according to claim 2, wherein the step of sending the encrypted data to the storage area includes a step of encapsulating the encrypted data within a SyncML document.

The office action concedes that the combination of *Nordeman*, *Linden* and *Caldwell* does not teach encapsulating encrypted data within a SyncML document. The office action alleges that *Linden* teaches encapsulating coded data within a wireless mark-up language and that it would have been obvious to make the invention adapted to include sending the encrypted data to a storage area including the steps of encapsulating the encrypted data within a SyncML document because it would allow for secure data transmission between servers and wireless communications devices, which are connected to communications network.

Applicants respectfully traverse this rejection of claim 3 for at least two reasons. First, there is no teaching in any of the cited references of a SyncML document, nor is there any suggestion in these references to modify them to use a SyncML document. Thus, the cited references are completely devoid of any teaching of a SyncML document. Second, the office action does not point to anywhere in these references where a motivation to combine them is evident, instead relying on a generalized statement that could apply to almost any two references in the field of telecommunications. Again, this is impermissible hindsight. As a result, applicants submit that claim 3 is allowable for at least these additional reasons over the prior art.

Claims 12 and 15 depend from allowable base claim 11 (see discussion below). As discussed in connection with claim 11, neither of *Nordeman* or *Caldwell* (the references cited against claim 11) teach selecting data for backup in a wireless device as recited in amended claim 11. The addition of *Linden* in the rejection of claims 12 and 15 does not cure this deficiency. As a result, Applicants submit that these claims are allowable. Moreover, claim 15 is further allowable for the same reasons discussed in connection with claim 3 above.

With respect to claim 18, the office action alleges that *Nordeman* teaches a memory storing data, selecting data for backup storage, and sending selected data to a storage area

accessible to a wireless terminal device through a wireless device. The office action concedes that *Nordeman* does not teach data encryption, sending encrypted data, or a browser that allows a user to select data for backup. In an attempt to overcome these admitted deficiencies, the office action relies on *Linden* and *Caldwell*, contending that *Linden* teaches a browser used in a wireless device to control a user interface, and that *Caldwell* teaches encrypting selected data. The office action further alleges that it would have been obvious to combine the teachings of these references to produce the claimed device.

Claim 18 recites (emphasis added):

> A wireless terminal device, comprising:
> . a memory storing data;
> a browser that allows a user to select data for backup storage;
> a backup module encrypting the selected data; and
> a backup application sending the encrypted selected data to a
> storage area that is accessible to the wireless terminal device through a
> wireless network.

As discussed above, none of the cited references teach or suggest selecting data for backup storage as recited in claim 18. Additional distinction may be drawn between claim 18 and the prior art in that none of the cited references, alone or in combination, show allowing a user to select data for backup storage. Further, none of the cited references teach or suggest a backup module that encrypts the selected data. Although *Caldwell* may teach encrypting data, it does so in the context of securing data transfers between servers, not between a wireless terminal device and a storage area on a wireless network. *Nordeman* may teach backing up wireless data, but there is no motivation found in either reference to combine the teachings of *Caldwell* and *Linden* with the teachings of *Nordeman* to achieve a backup module that encrypts selected data. As with claim 2, the office action relies on impermissible hindsight to combine the teachings of these references. The office action points to nothing specific in any of the cited references, but rather relies on a broad generalization that could apply to almost any two references in the telecommunications field.

As a result, claim 18 is allowable. Claims 19-22 and 24-29 depend from allowable claim 18. Applicants submit that these claims are allowable as being dependent on an allowable base claim and further in view of additional advantages and features recited therein. For example,

claim 21 is allowable for substantially the same reasons as discussed in connection with claims 3 and 15 above.

Rejections Based on *Nordeman* in view of *Caldwell*

The office action rejected claims 11, 13-14, and 16 under 35 U.S.C. § 103(a) as unpatentable over *Nordeman* in view of *Caldwell*.

With respect to claim 11, the office action stated that *Nordeman* teaches accessing backed up data in a wireless network from a wireless device and downloading data from a storage area that is accessible by a wireless client device through a wireless network. The office action concedes that *Nordeman* does not specifically teach backup data containing encrypted data decrypting the downloaded backed-up data. The action relies on *Caldwell* to cure this deficiency, arguing that *Caldwell* teaches decrypting the encrypted data.

Applicants have amended claim 11 to point out the inventive features therein with more particularity. Specifically, claim 11 as amended recites in relevant part:

> downloading the backed-up data from a storage area, the backed
> up data having been previously selected for backup, the backed-up
> data further containing encrypted data and the storage area being
> accessible by the wireless device through the wireless network

As discussed previously with respect to claims 2 and 18, none of the cited references teach selecting data for backup in a wireless device as recited in amended claim 11. In addition, the office action fails to point to any place in either reference where there is a suggestion or motivation to combine. As discussed above, the office action points to nothing specific in any of the cited references, but rather relies on a broad generalization that could apply to almost any two references in the art of telecommunications. Thus, claim 11 is also allowable.

Claims 13, 14 and 16 depend from allowable claim 11. As a result, these claims are also allowable as being dependent on an allowable base claim.

Rejections Based on *Nordeman* in view of *Caldwell, Linden*, and *Soini*

Claims 5, 17, and 23 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over *Nordeman* in view of *Caldwell, Linden* and *Soini* et al., U.S. Pat. No. 6,445,932 (hereinafter *Soini*). Applicants respectfully traverse. Each of these claims is dependent on an allowable base claim (claims 1, 11, and 18 respectively). As a result, Applicants submit that these claims are

also allowable over the prior art.

Conclusion

It is believed that no fee is required for this submission. If any fees are required or if an overpayment is made, the Commissioner is authorized to debit or credit our Deposit Account No. 19-0733 accordingly.
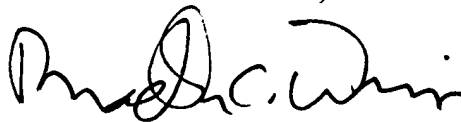
All rejections having been addressed, Applicants respectfully submit that the instant application is in condition for allowance, and respectfully solicits prompt notification of the same.

Respectfully submitted,

BANNER & WITCOFF, LTD.

Dated: March 19, 2004   By: _____

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